

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-2 are pending in the application, with claim 1 being the independent claim.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Double Patenting Over Co-pending Application No. 10/591,674

The Examiner has provisionally rejected claim 1 on the grounds of non-statutory obviousness-type double patenting over claim 4 of co-pending Application No. 10/591,674 ("the '674 application"). Applicants respectfully traverse this rejection.

First, Applicants note that this rejection is provisional and request that the Examiner hold this rejection in abeyance until allowable claims are identified in the '674 application.

Obviousness-type double patenting is a judicially created doctrine that "prohibit[s] a party from obtaining an extension of the right to exclude through claims in a later patent that are not patentably distinct from claims in a commonly owned earlier patent." *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 967 (Fed. Cir. 2001). There are two steps in an obviousness-type double patenting analysis. First, one "construes the claim[s] in the earlier patent and the claim[s] in the later patent and determines the differences." *Id.* at 968. Second, one determines whether those differences render the claims patentably distinct. *Id.* "A later patent claim is not patentably distinct from an

earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim."

Id.

Claim 4 of the '674 application claims is generally directed to the use of a combination of herbicide compounds to control unwanted plants. In contrast, claim 1 of the present application is directed specifically to controlling *Apera* using the compound of formula I alone. Thus, Applicants respectfully assert that this rejection is unfounded because: (i) the current claims are not drawn to a combination of herbicides; and (ii) the current claims specifically recite controlling *Apera* with a specific compound within the claims of the '674 application. There is nothing in the claims of the '674 application that would lead one of ordinary skill in the art to choose the specific compound of the present claims for use specifically for controlling *Apera*.

Reconsideration and withdrawal of this rejection is respectfully requested.

Double Patenting Over U.S. Patent No. 6,964,939

The Examiner has also rejected claim 1 on the grounds of non-statutory obviousness-type double patenting over claim 3 of U.S. Patent No. 6,964,939 ("Gesing *et al.*"). Applicants respectfully assert that this rejection is unfounded, because the claims of Gesing *et al.* would not lead a person of ordinary skill in the art to use the claimed compound especially on *Apera*.

Claim 3 of Gesing *et al.* is generally directed to controlling undesirable vegetation, comprising allowing a compound of formula I to act on the undesirable vegetation. In contrast, pending claim 1 specifically recites the control of *Apera* by applying a compound of formula I. Nothing in claim 3 of Gesing *et al.* would lead a person of ordinary skill in the art to the use the claimed compound specifically on *Apera*.

In addition, Applicants have surprisingly found that the compound of formula I is extremely effective against *Apera* relative to other unwanted vegetation. Specifically, as evidenced by the data presented below and in the Declaration Under 37 C.F.R. § 1.132 ("the Declaration") filed herewith, the compound of formula I effectively eradicates the weed *Apera* while having little to no impact on the surrounding crop plants, even when applied in connection with a safener, such as mefenpyr-diethyl.

Plant Variety	Compound I (g ai/ha)	Mefenpyr-diethyl (g ai/ha)	Damage (%)
<i>Apera spica-venti</i>	7.5	22.5	97
<i>Alopecurus myosuroides</i>	7.5	22.5	57
<i>Phalaris spp.</i>	7.5	22.5	43
<i>Poa annua</i>	7.5	22.5	15

These data were obtained under conditions identical to those described at page 12, paragraphs 0107 to 0114 of the present application (US2008/0020932 A1). As also indicated at page 12, paragraph 0014, the use of the claimed compound has little to no effect on the surrounding crop, causing only 4% damage.

One of ordinary skill would not have expected that the specifically claimed compound of formula I would be so effective at specifically controlling *Apera* from the teachings of claim 3 of Gesing *et al.*

Reconsideration and withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. § 103(a)

The Examiner has also rejected claims 1 and 2 under 35 U.S.C. § 103(a) as obvious in view of Gresling *et al.* Applicants respectfully traverse this rejection.

Applicants respectfully assert that the Examiner has failed to properly establish a *prima facie* case of obviousness against the currently pending claims. First, Gesing *et al.* qualifies as prior art to the currently pending claims under 35 U.S.C. 102(e). In addition both Gesing *et al.* and the currently pending application are commonly owned. Thus, Gesing *et al.* cannot be cited against the pending application in a rejection under 35 U.S.C. § 103 because it is subject to the 35 U.S.C. the § 103(c) exception.

However, even if the disclosure of Gesing *et al.* was eligible as prior art against the pending application in a rejection under 35 U.S.C. § 103, there is nothing in Gesing *et al.*, the knowledge in the art, and the nature of the problem to be solved, that would lead a person of ordinary skill in the art to use the claimed compound of formula I especially to control *Apera* as claimed in the present application.

Gesing *et al.* discloses generally a method of controlling unwanted vegetation by applying the compound of formula I to that vegetation. However, as the Examiner notes, "Gesing *et al.* do not teach an exemplification of the instant compound being applied to the *Apera* species." In contrast to Gesing *et al.*, the present invention is directed to specifically controlling *Apera* using the compound of formula I. Accordingly, a *prima facie* case of obviousness has not been established. Withdrawal of this rejection is respectfully requested.

Even if the Examiner has properly establish a *prima facie* case of obviousness over the cited art against the currently pending claims, which Applicants respectfully assert she has not, the presently claimed method shows a surprisingly effective result even when the claimed compound is applied to *Apera* at low concentrations. In fact, as evidenced at page 12, paragraphs 0107 to 0114 of the present application

(US 2008/0020932 A1) and in the Declaration filed concurrently herewith, the claimed compound I effectively eradicates the weed *Apera* while having little to no impact on the surrounding crop plants, even when applied in connection with a safener, such as mefenpyr-diethyl. Moreover, Applicants have surprisingly found that the claimed compound I is effective specifically against *Apera* when used at 7.5 g ai/ha. In contrast, the data in Gesing *et al.* was obtained with application rates of 60 g ai/ha. It is absolutely unexpected that decreasing the application rate of the compound of formula I taught in Gesing *et al.* by a factor of 8 (7.5 g ai/ha versus 60 g ai/ha) would result in extremely effective weed control of the species *Apera* compared to other weed species. This surprising result was not suggested and would certainly not be expected from the disclosure of Gesing *et al.* This unexpected result renders the currently claimed method non-obvious.

Reconsideration and withdrawal of the outstanding rejection is earnestly solicited.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.


Amdt. dated August 1, 2008 - 7 -
Reply to Office Action of February 7, 2008

DOLLINGER *et al.*
Appl. No. 10/591,673

Prompt and favorable consideration of this Amendment and Reply is respectfully
requested.

Respectfully submitted,

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